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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,666	12/27/1999	KEITH C. THOMAS	98-1176	9062

32709 7590 02/24/2004

GATEWAY, INC.
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EXAMINER	
KEMPER, MELANIE A	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/472,666	THOMAS, KEITH C.	
	Examiner	Art Unit	
	M Kemper	3622	MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 November 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *19-39 and 55-65* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19-39, 55-65* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 19-39, 55-56 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ebisawa, patent number 5,946,664.

Ebisawa teaches a removable moving media comprising: a source content (video game); a removable content disposed within the source content (col. 3, lines 58-60); a communication assembly in connection with a virtual product source providing access to the source content and the removable content (col. 3, lines 20-35, col. 5, lines 12-21, 30-35, col. 6, lines 10-20, 35-38, col. 6, line 50- col. 8, line 25); wherein the communication assembly allows the virtual product source to place a virtual product within the removable moving media through utilization of the removable content disposed within the source content (col. 3, lines 58-60). Ebisawa also teaches a

method for placement of virtual product in a moving media, comprising selecting an original source media including a removable content, the removable content providing a virtual product location (col. 3, lines 20-35, col. 5, lines 12-20, col. 7, lines 30-67); receiving a virtual product content from a peripheral virtual product source (col. 7, lines 1-10, 30-67, col. 5, lines 12-20, col. 6, lines 12-19, lines 35-38); editing the original source media and inserting the virtual product content in the virtual product location of the original source media (col. 3, lines 50-60, col. 7, lines 10-25). Ebisawa also teaches a system for placing virtual products within a moving media comprising an original moving media content source including a removable content, the removable content providing a virtual product location (col. 3, lines 20-35); a network in communication with the original moving media content source, the network providing a virtual product source (figs, 7-9 and related text, col. 5, lines 12-20); a virtual product disposed within the virtual product source, the virtual product being enabled for placement in the virtual product location of the removable content (advertisements described); wherein the virtual product is downloaded from the network and placed on the moving media in the virtual product location (col. 5, lines 12-20, lines 60-65, col. 3, lines 20-35, 55-60).

Ebisawa also teaches the virtual product source is at least one of a network and a peripheral computing system (col. 3, lines 60-65, col. 5, lines 12-20, figs. 7-9 and related text); the virtual product source updates the virtual product location on the removable content within the source content (col. 5, lines 35-50); the source content is a video game (col. 1, lines 15-20) wherein the source content is at least on of a streaming

video or video stream and a video file format (col. 7, lines 12-20, 50-60); the source content is a digital source content (col. 5, line 60 – col. 6, line 20). In this case, a virtual product refers to any object which is replaced or replaces in a scene for the purposes of providing advertising. To the extent that the claim to a virtual product may be interpreted differently, it would have been obvious to one having ordinary skill in the art at the time of the invention to have used a virtual product in Ebisawa since product placement is well known in the art for product exposure and advertisement purposes and would have been adopted for the intended use of the artistic choices of the game manufacturer and sponsor(s). It also would have been obvious to have the virtual product placed within the moving media through a paint process since this would have been adopted for the intended use of providing static advertisements such as on the billboard of Ebisawa.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification does not proved antecedent basis for the virtual product source is a network or a website on a network.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 57-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebisawa, patent number 5,946,664 in view of Margulis, patent number 6,456,340.

Ebisawa substantially teaches the invention as described above, but does not show a virtual product is a commercial item associated with a brand identity or the commercial product comprises packaging containing a consumable product or a can of beer. Margulis teaches replacement of objects including a commercial item associated with a brand identity or the commercial product comprises packaging containing a consumable product (col. 16, line 59 – col. 17, line 5). It would have been obvious to one having ordinary skill in the art at the time of the invention to have inserted/replaced an object in Ebisawa as in Margulis since the objects of Margulis are used as advertisements and would have been adopted for the intended use of updated advertising. It also would have been obvious to have the commercial item as a can of beer since this would have been adopted for the intended use of a beer manufacturer advertising campaign.

7. Applicant's arguments filed on 11/14/03 have been fully considered but they are not persuasive. The examiner maintains that the virtual product source is a network or a website on a network is not shown in the specification. The portions cited by the applicant do not support that the *virtual product source* is a network or a website on the network. However, upon further reconsideration, at best, it can be considered implicit. However, antecedent basis for claim language in the specification is required. No new matter may be entered.

The applicant argues that Ebisawa does not teach a "system of replacing commercial items in moving content with other items." However, this is not the claim language of the present application. The applicant attempts to read the specification into the claims throughout his response. While the claims are read in light of the specification, it is improper to read the specification into the claims.

The virtual products are, in essence, objects which can be replaced. This is shown in Ebisawa in the form of replacing advertisements. The design of the object or advertisement replaced is determined by the advertiser and/or manufacturer. This is further supported by Margulis which shows the replacement of the can of soda for advertisement purposes.

The applicant challenges use of the paint process as in the dependent claims. However, the challenge is improper since no rationale was provided as to why it is not well known to use a paint process. Regardless, Sheasby et al., patent number 6,473,094 provided in the previous action, teaches using a paint process in editing video (col. 6, lines 45-50, 60-67).

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Kemper whose telephone number is 703-305-9589. The examiner can normally be reached on M-F (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

M Kemper
Primary Examiner
Art Unit 3622

MK